

REMARKS

The Official Action mailed November 3, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on August 22, 2003, and August 2, 2004.

Claims 1-29 are pending in the present application, of which claims 1, 5, 10, 16 and 20 are independent. The independent claims have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 1-29 under the doctrine of obviousness-type double patenting over the combination of claims 1-24 of U.S. Patent No. 6,618,105 to Yamazaki et al. and U.S. Patent No. 5,193,017 to Iwai et al. The Applicants respectfully submit that the amended independent claims of the subject application are patentably distinct from the claims of the Yamazaki patent either alone or in combination with Iwai.

As stated in MPEP § 804, under the heading "Obviousness-Type," in order to form an obviousness-type double patenting rejection, a claim in the present application must define an invention that is merely an obvious variation of an invention claimed in the prior art patent, and the claimed subject matter must not be patentably distinct from the subject matter claimed in a commonly owned patent. Also, the patent principally underlying the double patenting rejection is not considered prior art.

The Applicants respectfully traverse the obviousness-type double patenting rejection because the independent claims of the present application are patentably distinct from the claims of Yamazaki either alone or in combination with Iwai. Specifically, the independent claims of the present application have been amended to recite that a transparent material has a cured portion and an uncured portion, that the cured portion surrounds the liquid crystal, and that the uncured portion is disposed

under the black coating (see the specification at page 14, lines 6-12). The claims of Yamazaki either alone or in combination with Iwai do not teach or suggest at least the above-referenced features.

Therefore, the Applicants respectfully submit that the subject application is patentably distinct from the claims of the Yamazaki patent. Reconsideration of the obviousness-type double patenting rejection is requested.

The Official Action rejects claims 1-9, 25 and 26 as obvious based on the combination of U.S. Patent No. 5,543,945 to Kimura et al. and JP 62-178905; claims 10-15 and 27 as obvious based on the combination of U.S. Patent No. 5,003,356 to Wakai et al., U.S. Patent No. 5,305,126 to Kobayashi et al. and Iwai; and claims 16-24, 28 and 29 as obvious based on Kimura, page 7, lines 12-21 of the Applicants' specification, which the Examiner alleges is prior art and refers to as Applicant's Prior Art Admission (APAA), and JP '905. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365,

1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. As noted above, the independent claims have been amended to recite that a transparent material has a cured portion and an uncured portion, that the cured portion surrounds the liquid crystal, and that the uncured portion is disposed under the black coating. Kimura, JP '905, Wakai, Kobayashi, Iwai and the APAA, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention.

Since Kimura, JP '905, Wakai, Kobayashi, Iwai and the APAA do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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